

REMARKS

This Response is submitted in reply to the Office Action mailed April 21, 2004. Claims 1, 3, 5, 10, 16 and 17 have been amended. Claims 19 and 20 have been canceled without prejudice or disclaimer. New Claims 24 and 25 have been added. No new matter is introduced by way of these amendments and additions.

A Terminal Disclaimer is submitted herewith. A Petition for a One-Month Extension of time to respond to the Office Action is submitted herewith. A check in the amount of \$392.00 is submitted herewith to cover the cost of the one-month extension, the cost of the new claims and the cost of the Terminal Disclaimer. Please charge deposit account No. 02-1818 for any insufficiency or to credit any overpayment.

Applicants respectfully request that the references submitted on October 20, 2003 be considered with respect to the present patent application. A copy of the Information Disclosure Statement submitted on October 20, 2003 is submitted herewith.

Claims 1, 2, 4, 13 to 16, 18 and 21 to 23 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 to 12 of U.S. Patent No. 6,669,559 to Baerlocher et al. ("Baerlocher") in view of U.S. Patent No. 5,494,287 to Manz ("Manz"). A Terminal Disclaimer is submitted herewith to overcome these rejections.

The Office Action rejected Claims 1 to 6, 13 to 18, 21 to 23 under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,190,255 to Thomas ("Thomas") in view of Manz.

Thomas relates to a gaming machine operable in a basic game and a bonus game. The bonus game provides a plurality of masked selection elements. Each selection element is associated with a particular bonus game outcome. The bonus game outcomes consist of various numerical outcomes (such as, coin/credit values) and various non-numerical outcomes (such as, "end-bonus" outcomes). As play begins, the player selects, one at a time, an element from the plurality of masked selection elements. The bonus game outcome associated with the selected element is revealed. If the revealed bonus outcome is associated with an "end-bonus" outcome, the bonus

game is terminated. If the revealed bonus outcome is associated with a numerical outcome, the player is provided the associated award value and the player may select another element. This process continues with the player selecting elements, one at a time, until selecting an element associated with an “end-bonus” outcome, which terminates the bonus game. In one embodiment, if the revealed bonus outcome is associated with an “end-bonus” outcome, the player may exercise a bonus game resource, if such resource has been obtained in the basic game, to overcome an “end-bonus” outcome and continue play of the bonus game (col. 19; line 59 to col. 20, line 20).

Manz is directed to a payout system and method for gaming that permits the random selection of a payout for a particular game outcome from a predetermined range of payout amounts. The player is provided with a range of possible payouts that may be paid upon the occurrence of particular outcome. When the player initiates game play, an input-output interface generates an initiate signal. If a winning game outcome occurs, the microprocessor randomly selects a payout amount from a predetermined range of payout amounts stored in memory. A meter displays the metered payout amount.

Applicants have amended independent Claims 1 and 13 to each include the plurality of symbols including at least one termination symbol. The claims have also been amended to include at least one termination scheme associated with the termination symbol which includes a predetermined number of picks.

The Office Action states “the prior art does not teach or suggest a game terminating scheme in which a symbol causes a game to end after allowing players a limited number of additional picks.” Therefore, Applicants respectfully submit that amended independent Claims 1 and 13 are patentably distinguished over the combination Thomas and Manz and are in condition for allowance. Claim 2 (depending from Claim 1) and Claims 14 to 16 (depending from Claim 13) are allowable for the reasons given with respect to Claims 1 and 13 and are in condition for allowance.

Applicants have amended independent Claims 3 and 17 to each include the plurality of symbols including at least one termination symbol. The claims have also

been amended to include at least one termination scheme associated with the termination symbol wherein the game terminates upon a next pair of related symbols being displayed by the display device.

The Office Action states "the prior art does not teach or suggest a game terminating scheme in which a symbol causes the game to end after allowing players to receive an additional pair of related symbols." Therefore, Applicants respectfully submit that amended independent Claims 3 and 17 are patentably distinguished over the combination of Thomas and Manz and are in condition for allowance. Claims 2 to 6 (depending from Claim 3) and Claims 18 and 20 to 23 (depending from Claim 17) are allowable for the reasons given with respect to independent Claims 3 and 17 and are in condition for allowance.

The Office Action objected to Claims 19 and 20 as being dependent upon a rejected base claim, but indicated that Claims 19 and 20 would be allowable if rewritten in independent form. Accordingly, Applicants have canceled original Claims 19 and 20 and added new Claims 24 and 25 to substantially capture the subject matter of the objected to claims. No new matter has been added by way of these claims.

Additionally, the Office Action allowed independent Claim 10. Applicants have amended Claim 10 for clarification purposes only.

An earnest endeavor has been made to place this application in condition for formal allowance and, in the absence of more pertinent art, such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 
Adam H. Masia
Reg. No. 35,602
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4284

Dated: August 23, 2004